

## **REMARKS**

**[0002]** Applicant respectfully requests reconsideration and allowance of all of the claims of the application. The status of the claims is as follows:

- Claims 1-5, 7-51, 54, 56-62, 64-75, and 77-82 were pending.
- Claims 32-34 and 79 are amended herein.
- Claims 1-5, 7-51, 54, 56-62, 64-75, and 77-82 are currently pending.

### **Allowed Claims**

**[0003]** The Office Action indicates that claims 1-5, 7-31, 45-51, 53-54, 56-62, 64-75, and 77-82 are allowable. Applicant would like to thank the Examiner for allowing these claims. These claims have not been amended other than to correct a minor informality in dependent claim 79 and therefore remain in condition for allowance.

### **Claims 32-44 Recite Statutory Subject Matter Under § 101**

**[0004]** Claims 32-44 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Applicant respectfully traverses this rejection.

**[0005]** Nevertheless, for the sole purpose of expediting prosecution, Applicant herein amends claims 32-44 as shown above. Applicant respectfully submits that these amendments render the § 101 rejection moot.

**[0006]** Applicant amends claims 32-44 to recite, in part, “computer storage media.” Applicant's specification defines “computer readable media” as comprising both “computer storage media” and “communication media,” and provides clear definitions of all terms. (See Specification, page 35, line 6 – page 36, line 4.) “Computer storage

media” is specifically defined in Applicant's specification as encompassing many types of volatile, non-volatile, removable, and non-removable media (e.g., RAM, ROM, EEPROM, flash memory or other memory technology, CD-ROM, digital versatile disks (DVD) or other optical storage, magnetic cassettes, magnetic tape, magnetic disk storage or other magnetic storage devices) that can be used to store information which is accessed by a computer. In contrast, “communication media” is specifically defined to include modulated data signals such as carrier waves or any other information delivery media.

**[0007]** Even assuming for the sake of argument that a claim directed to “communication media” would recite non-statutory subject matter, Applicant's claims 32-44 are not directed to “communication media.” Regarding claims 32-44, Applicant hereby specifically and affirmatively disclaims any coverage of non-statutory subject matter, modulated data signals, or carrier waves.

**[0008]** The Office Action addressing claims 32-44, prior to the current amendments, asserts that a “computer-readable medium” can be broadly interpreted to include a signal which is non-statutory subject matter. (See Office Action, page 2.) Applicant respectfully disagrees with this assertion. Nevertheless, that issue is now moot because the claims 32-44, as amended, recite “computer storage media” not “computer-readable medium,” and as defined in the specification, “computer storage media” cannot be broadly interpreted to include a signal, as signals are clearly defined to be encompassed by “communication media.”

**[0009]** A determination as to whether or not a claim complies with the statutory requirements of §101 begins with claim construction. “As in any other context in which

the scope and meaning of the claims bears on the ultimate determination at hand, we must start by considering the issue of claim construction” *In re Nuijten*, 2006-1371, slip op. at 9 (Fed. Cir. September 20, 2007). “Computer storage media” as currently recited in Applicant's claim 32-44 may not be interpreted to include modulated data signals and/or carrier waves. These claims must be construed consistent with the specification. The Court of Appeals for the Federal Circuit has instructed that claim construction be “consistent with the specification,... and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Suitco Surface, Inc.* 2009-1418, slip op. at 8 (Fed. Cir. April 14, 2010) emphasis in original; (quoting *In re Bond*, 910 F.2d 831, 833 (Fed. Cir. 1990)). Given that Applicant's specification uses “communication media” to refer to modulated data signals and/or carrier waves, claims 32-34 may not be properly construed as including signals because these claims are directed to “computer storage media” not “communication media.”

**[0010]** Applicant notes that determining if a claim recites statutory subject matter is a question of law. “Whether a claim is valid in light of § 101 is a question of law that we review *de novo*” (*AT&T Corp. v. Excel Commc’ns, Inc.*, 172 F.3d 1352, 1355 (Fed. Cir. 1999). Applicant submits that claims 32-44 are directed to a manufacture (i.e., computer storage media) which is one of the statutory categories recognized by 35 U.S.C. §101. Additionally, Applicant's claims 32-44 may be distinguished from the claims found non-statutory by the court in *Nuijten*, because Nuijten’s claims recited “a signal” whereas the currently rejected claims in this application do not recite signals or “communication media.” The prohibition on patenting “signals” established in *Nuijten* is

not relevant to Applicant's currently pending claims. Therefore, Applicant's claims 32-44 comply with both statutory law (i.e., §101) and judge-made law (i.e., *Nuijten*).

**[0011]** For all the above reasons, Applicant respectfully requests withdrawal of the rejection of claims 32-34.

## **Conclusion**

**[0012]** For at least the foregoing reasons, all pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the application. The amendments and remarks presented herein are responsive to the new grounds of rejection, and therefore, could not have been presented earlier. If any issues remain that would prevent allowance of this application, **Applicant requests that the Examiner contact the undersigned representative before issuing a subsequent Action.**

Respectfully Submitted,

Lee & Hayes, PLLC  
Representative for Applicant

\_\_\_\_\_/Benjamin Keim 59,217/\_\_\_\_

Dated: \_\_\_\_\_ May 19, 2010 \_\_\_\_\_

Benjamin A. Keim  
(benjamink@leehayes.com; 509-944-4748)  
Registration No. 59217

Kayla D. Brant  
(kayla@leehayes.com; 509-944-4742)  
Registration No. 46576